



MEMORANDUM

DATE: November 12, 2002

TO: Bruce Kisliuk, Director  
Technology Center 1642

FROM: *Sherry D. Brinkley*  
Sherry D. Brinkley  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

SUBJECT: Application No. 08/488,180

The above-identified application is being referred to the Technology Center to consider the petition to withdraw the application from issue under 37 CFR 1.313(a). While the issue fee has been paid, a patent number and issue date have not yet been assigned. If it is deemed necessary to withdraw the case, please do so, per authority granted to you by Deputy Assistant Commissioner Kunin's memo of January 20, 1999. See attached.

Attachment



B. Ba Hk

7-1

MEMORANDUM

DATE: January 20, 1999

TO: Technology Center Group Directors

FROM: Stephen G. Kunin *Stephen G. Kunin*  
Deputy Assistant Commissioner for  
Patent Policy and Projects

SUBJECT: Delegation of authority to withdraw an application from issue after payment of the issue fee.

You are hereby delegated the authority to withdraw an application from issue after payment of the issue fee under 37 CFR 1.313(b). This grant of authority is limited to those situations in which the request for withdrawal from issue is at the initiative of the Patent and Trademark Office (PTO). You may **not** further delegate this grant of authority.

The authority to decide petitions by an applicant under 37 CFR 1.313(b) is delegated to the Office of Petitions. The Office of Petitions is also delegated the authority to withdraw an application from issue after payment of the issue fee under 37 CFR 1.313(b) in those situations in which the request for withdrawal from issue is at the initiative of the PTO by someone other than a Group Director.

35 U.S.C. § 151 provides that upon payment of the issue fee, "the patent shall issue." See 35 U.S.C. § 151, ¶ 2. Thus, an application cannot be withdrawn from issue after payment of the issue fee consistent with 35 U.S.C. § 151 unless there has been a determination that at least one of the conditions specified at 37 CFR 1.313(b)(1) through (5) exist such that the applicant is no longer "entitled to a patent under the law" as provided in 35 U.S.C. § 151. See *Harley v. Lehman*, 981 F. Supp. 9, 11-12, 44 USPQ2d 1699, 1701-02 (D.D.C. 1997) (Commissioner may adopt rules permitting applications to be withdrawn from issue after payment of the issue fee in situations in which the applicant is not entitled to a patent under the law); and see *Sampson v. Dann*, 466 F. Supp. 965, 973-74, 201 USPQ 15, 22 (D.D.C. 1978) (Commissioner not authorized to withdraw an application from issue after payment of the issue fee on an *ad hoc* basis, but only in situations which meet the conditions of 37 CFR 1.313(b)).

35 U.S.C. § 151 and 37 CFR 1.313(b) do not authorize the PTO to withdraw an application from issue after payment of the issue fee for any reason **except**:

- (1) a mistake on the part of the Office;
- (2) a violation of 37 CFR 1.56 or illegality in the application;

- (3) unpatentability of one or more claims;
  - (4) for interference; or
  - (5) for abandonment to permit consideration of an information disclosure statement under 37 CFR 1.97 in an already filed continuing application.
- See 37 CFR 1.313(b).*

Examples of reasons that do **not** warrant withdrawing an application from issue after payment of the issue fee are: (1) to permit the examiner to consider an information disclosure statement; (2) to permit the examiner to consider whether one or more claims are unpatentable; or (3) to permit the applicant to file a continuing application (including a CPA). An application may be removed from the Office of Patent Publication, without it being withdrawn from issue under 37 CFR 1.313(b), to permit the examiner to consider an information disclosure statement or whether one or more claims are unpatentable. Only if such consideration results in a determination that one or more claims are unpatentable does 37 CFR 1.313(b) authorize the application to be withdrawn from issue. If uncertainty exists as to whether prosecution will in fact be re-opened, the uncertainty must be resolved before the application is withdrawn from issue.

Any notice withdrawing an application from issue after payment of the issue fee must specify which of the conditions set forth in 37 CFR 1.313(b)(1) through (5) exists and thus warrant withdrawal of the application from issue.

Any petition under 37 CFR 1.181 to review the decision of a Group Director to withdraw an application from issue after payment of the issue fee will be decided by me.

As discussed above, the Office of Petitions also has the authority to withdraw an application from issue after payment of the issue fee under 37 CFR 1.313(b) in those situations in which the request for withdrawal from issue is at the initiative of the PTO by someone other than a Group Director. If there is a question whether an application must be withdrawn from issue and no Group Director is available to decide whether withdrawal from issue is appropriate and to sign the withdrawal Notice, the application should be hand-carried to the Office of Petitions for decision on whether withdrawal from issue is appropriate and to effect the withdrawal.

Questions concerning withdrawal from issue may be directed to the Office of Petitions at 305-9282.

The procedure set forth below is to be followed when a Group Director withdraws an application from issue. This processing is to be done in the Technology Center without the need to send the application to the Office of Patent Publication.

These procedures will be incorporated into the next revision of the MPEP.

**Procedure to be followed when an application is withdrawn from issue:**

Determine (via the CRT Screen on PALM) whether the issue fee has been paid, and whether the application has been assigned a patent number and issue date.

(1) If the issue fee **has not** been paid: withdraw the application from issue in accordance with the procedure set forth in MPEP 1002.02(c), item 18 (as modified by the memorandum of January 16, 1998 entitled "New File Wrappers"), using form paragraph 10.01.

(2) If the issue fee **has** been paid:

(a) Prepare, sign, date stamp, and mail a "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" **to the applicant** indicating that the application has been withdrawn from issue (using one of the attached form letters WDR-TCB1, WDR-TCB2, WDR-TCB3, or WDR-TCB4). **Do NOT use form paragraph 10.02 to effect withdrawal of an application from issue because it is now obsolete.**

(b) **If the application has been assigned a patent number and issue date:**

(i) Prepare a "Withdrawal from Issue of" memorandum using the attached form memorandum WDR-MEMO. **E-mail the memorandum to the Director of the Office of Patent Publication and the persons copied on the memorandum to inform them that the application has been withdrawn from issue.**

(ii) The "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" letter to applicant discussed in (a) must be signed, date stamped, and mailed no later than the Monday before the issue date to be effective to withdraw the application from issue.

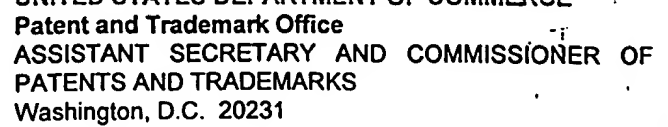
(c) Change the status of the application to status code 066 (Previous Action Withdrawn-Awaiting Further Action) by using PALM transaction code 1040. Enter the "Notice of Withdrawal From Issue under 37 CFR 1.313(b)" (and the "Withdrawal from Issue of" memorandum discussed in (b)(i) above if applicable) in the application file and make it (them) of record on the application file contents.

(d) Stick an Issue Information Label (Form 2016) on the file wrapper (see the memorandum of January 16, 1998 entitled "New File Wrappers") over the filled-in boxes on the file wrapper that contain issue information.

(e) Forward the application to the examiner for **prompt** appropriate action (*e.g.*, reopen prosecution, initiate interference proceedings).

Attachments: Form Letters WDR-TCB1  
WDR-TCB2  
WDR-TCB3  
WDR-TCB4  
WDR-MEMO

Memorandum of January 16, 1998 entitled "New File Wrappers"  
Issue Information Label (Form 2016)



## WDR-TCB1

KEYBOARD()

## KEYBOARD

Application No. **KEYBOARD**

Filed: **KEYBOARD**

Attorney Docket No. **KEYBOARD()**

**NOTICE OF WITHDRAWAL  
FROM ISSUE  
UNDER 37 CFR 1.313(b)**

The above-identified application is withdrawn from issue after payment of the issue fee due to a mistake on the part of the Office. See 37 CFR 1.313(b)(1).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to KEYBOARD at (703) KEYBOARD.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

KEYBOARD()

**WDR-TCB2**

KEYBOARD()

## KEYBOARD

Filed: **KEYBOARD**

Attorney Docket No. **KEYBOARD**

**NOTICE OF WITHDRAWAL  
FROM ISSUE  
UNDER 37 CFR 1.313(b)**

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to **KEYBOARD()** at (703) **KEYBOARD()**.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

## KEYBOARD()



Paper No. KEYBOARD()

WDR-TCB3

KEYBOARD()  
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In re Application of

KEYBOARD()

Application No. KEYBOARD()

Filed: KEYBOARD()

Attorney Docket No. KEYBOARD()

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**NOTICE OF WITHDRAWAL  
FROM ISSUE  
UNDER 37 CFR 1.313(b)**

The above-identified application is withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. See 37 CFR 1.313(b)(3).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to KEYBOARD() at (703) KEYBOARD().

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

KEYBOARD()





Paper No. KEYBOARD

In re Application of  
KEYBOARD®  
Application No. KEYBOARD®  
Filed: KEYBOARD®  
Attorney Docket No. KEYBOARD®

The above-identified application is withdrawn from issue after payment of the issue fee for interference. See 37 CFR 1.313(b)(4).

The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. This request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to KEYBOARD@ at (703) KEYBOARD@.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

## KEYBOARD()



Paper No. KEYBOARDQ

WDR-MEMO

Date : DATE  
TO : Director, Office of Patent Publication  
FROM : Director, Technology Center KEYBOARDQ  
SUBJECT : Withdrawal from Issue of

Applicant : KEYBOARDQ  
Application No. : KEYBOARDQ  
Filed : KEYBOARDQ

The above-identified application has been assigned Patent No. KEYBOARDQ and an issue date of KEYBOARDQ.

The above-identified application has been withdrawn from issue.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of KEYBOARDQ:

"All reference to Patent No. KEYBOARDQ to KEYBOARDQ of KEYBOARDQ for KEYBOARDQ appearing in the Official Gazette of KEYBOARDQ should be deleted since no patent was granted."

KEYBOARDQ

KEYBOARDQ

cc: Geraldine Dozier, Office of Electronic Information Products, Crystal Park 3-441  
Deneise Boyd, Office of System and Network Management, Crystal Park 2, Suite 1100  
Nancy Hurd, Office of Patent Publication, Crystal Park 3-910  
Niomi Farmer, Office of Patent Publication, Crystal Park 3-910